

Remarks

STATUS OF CLAIMS

Claims 1, 4, 7, and 10 have been amended; claims 1-12 are currently pending in the present application.

REMARKS

In the current Office Action, the Examiner:

rejected claims 1-4 and 7-10 under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 5,455,953 (hereinafter referred to as "Russell"); and

rejected claims 5-6 and 11-12 under 35 U.S.C. §103(a) as being unpatentable over Russell in view of U.S. Patent No. 5,960,411 ("Hartman").

1. Response to Rejections Under 35 U.S.C. §102

- a. The Russell Patent does not disclose every element and feature of the claims and therefore cannot support a proper anticipation rejection under 35 U.S.C. §102(b).

35 U.S.C. §102(b) states in relevant part that "[a] person shall be entitled to a patent unless the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of the application for patent in the United States..." For rejections based on anticipation, there is no question of obviousness or modification of the reference, rather a single reference must teach each, every, and all aspects of the claimed invention either explicitly or impliedly, and any feature not directly taught must be inherently present. *Verdegaal Bros. v. Union Oil Co. Of California*, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987); MPEP §§706.02 and 2131. "The identical invention must be shown in as complete detail as is contained in the...claim." *Richardson v. Suzuki Motor Co.*, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). Furthermore, a prior art device can perform all of the functions of a claimed apparatus and yet not anticipate the claimed apparatus if the claimed apparatus and the prior art device are structurally distinguishable. *In re Robertson*, 49 USPQ2d 1949, 1951 (Fed. Cir. 1999); MPEP §2114. A rejection under 35 U.S.C. §102(b) is overcome by persuasively distinguishing the subject matter and language of the claims from that which is disclosed by the cited reference. MPEP §706.02(b).

The Applicant first notes that the Russell patent does not address or seek to solve the same problems as the present application. The Applicant acknowledges that this fact, without more, will not overcome an anticipation rejection under §102, but it does provide compelling explanation and support for the Applicant's arguments that the Russell patent does not disclose certain features of the present invention. The Russell patent cannot be said, for example, to implicitly or inherently disclose features that solve problems that the Russell patent is unconcerned with and does not address. For example, the Russell patent discloses using a directory server as a static user database. By contrast, the present invention uses the directory server to dynamically track user sessions. The Russell patent is also focused on removing the need for each server to pull information from the directory. By contrast, the present invention is focused on using the directory as a session-tracking database, thereby requiring other applications and servers to reference it when needed.

It is in this light that the Applicant addresses specific assertions by the Examiner as follows:

"Storing security information for users in a user profile database; Receiving at an authorization server coupled with the user profile database log-in information from user (col. 21, lines 64-67)."

Response: Russell describes a simple static user database, not a dynamic session-tracking system. Independent claims 1 and 7 have been amended to emphasize this distinguishing feature.

"Creating a Session ID on user's computer; storing the Session ID on the user's computer (col. 5, lines 35-40 and lines 44-53)."

Response: The indicated text discusses Session ID's, but does not discuss how or where they are stored. Thus, contrary to the Examiner's assertion, the Russell patent does not disclose the limitation of storing at least a portion of the Session ID on the user's computer, as appears in independent claims 1 and 7. The issue of how and where the Session IDs are stored is important to the present invention and the particular problems it seeks to solve.

"Stores the object in a directory coupled with the authorization server (col. 23, lines 1-3)."

Response: The Applicant respectfully asserts that the indicated text explicitly states that the object is not stored in the directory. Thus, contrary to the Examiner's assertion, the Russell patent does not disclose the limitation of storing the object in a directory coupled with the authorization server, as appears in independent claims 1 and 7.

"Copying the security information from the user profile database to the object in the directory (col. 22, lines 47-50)."

Response: The indicated text discusses how information is read *from* the directory, but does not discuss writing information *to* the directory. As mentioned, the Russell patent discloses using the directory as a static user database, which is completely different from the manner in which the present invention uses the directory. The Russell patent discloses a system that is at best complementary, rather than duplicative, of the present invention. For example, the system disclosed in the Russell patent might be used for authentication and the present invention might be used to keep track of the session and allow communication of the session information for all back-end applications and services.

"Comparing the log-in information to the security information to authenticate or authorize the user (col. 22, lines 5-6)."

Response: Again, this is a user look-up function from a static user database. The present invention does not discuss comparing authentication credentials to static directory information. Instead, the directory of the present invention is used after authentication.

"Permitting other computer applications launched by the user to reference the Session ID (col. 24, lines 62-67)."

Response: The Russell patent does not disclose how this is accomplished. The present invention uses dynamically-generated entries in the directory to communicate the common information. Independent claims 1 and 7 have been amended to emphasize this distinguishing feature.

"As per Claims 2 and 8, Russell teaches a method for Security information including authentication and authorization (col. 22, lines 2-6)."

Response: the indicated text discusses user look-up for authentication, not storage and maintenance of session information.

"As per Claims 3 and 9, Russell teaches a method for"

Response: The Examiner's statement ends abruptly; there appears to be an error.

"As per Claims 4 and 10, Russell teaches a method for Session ID based on an account code (col. 10, lines 66-67)."

Response: The present invention is preferably based on machine information rather than account codes. Account codes would require an additional index and lookup. Claims 4 and 10 have been amended accordingly.

2. Response to Rejections Under 35 U.S.C. §103

- a. The Russell Patent is non-analogous art with regard to the present invention and therefore cannot support a proper obviousness rejection under 35 U.S.C. §103.

The primary test for determining whether a prior art reference is properly analogous with respect to an invention is as follows:

Two criteria have evolved for determining whether prior art is analogous: (1) whether the art is from the same field of endeavor, regardless of the problem addressed, and (2) if the reference is not within the same field of the inventor's endeavor, whether the reference still is reasonably pertinent to the particular problem with which the inventor is involved. *In re Clay*, 23 USPQ2d 1058, 1060 (Fed. Cir. 1992).

Furthermore, an invention cannot be considered to be within the field of endeavor of a prior art reference merely because both relate to the same industry. *Id.* 1060. However, "[a] reference is reasonably pertinent if, even though it may be in a different field from that of the inventor's endeavor, it is one which, because of the matter with which it deals, logically would have commended itself to the inventor's attention in considering his problem". *Id.* 1061. Patent examination is necessarily conducted by hindsight, with

complete knowledge and benefit of the applicant's invention as a guide. *In re Oetiker*, 24 USPQ2d 1443, 1447 (Fed. Cir. 1992). For this reason, it is necessary to consider the "reality of the circumstances" in deciding in which fields a person of ordinary skill in the art would reasonably be expected to look for the solution to the problem facing the inventor. *Id.* 1447. Ultimately, a rejection based on non-analogous art cannot be sustained. *Id.* 1061.

The test set forth in *In re Clay* was tellingly applied, for example, in *Wang Laboratories, Inc. v. Toshiba Corp.*, which is cited by and discussed in MPEP §2141.01(a) in the context of determining analoguousness in the electrical arts. *Wang Laboratories, Inc. v. Toshiba Corp.*, 26 USPQ2d 1767 (Fed. Cir. 1993). Wang Laboratories, Inc. (hereinafter referred to as "Wang"), as assignee, brought suit against a number of parties, including Toshiba Corp. and NEC Corp., for infringement of U.S. Patent Nos. 4,656,605 (hereinafter referred to as the "605 patent") and 4,727,513 (hereinafter referred to as the "513 patent"). *Id.* 1070. These patents relate to and claim certain types of single in-line memory modules (SIMMs) (hereinafter referred to as the "Wang SIMMs"). *Id.* 1770. At trial, a jury found that SIMMs manufactured by Toshiba Corp. and NEC Corp. infringed certain claims of the '605 and '513 patents. *Id.* 1770. In relevant part, Toshiba Corp. and NEC Corp. moved for JNOV, which was denied, and thereafter appealed. *Id.* 1770.

On appeal, Toshiba Corp. and NEC Corp. argued that the claims at issue were invalid for obviousness under 35 U.S.C. §103 in light of U.S. Patent No. 4,281,392 to Allen-Bradley Co. and its commercial counterpart the X9 SIMM (hereinafter referred to as the "Allen-Bradley SIMM"). *Id.* 1772. Toshiba Corp. and NEC Corp. argued that the Allen-Bradley patent and the Allen-Bradley SIMM were analogous to the claimed subject matter and effective to render the relevant claims of the '605 and '513 patents invalid. *Id.* 1772.

The court held that an adequate jury instruction regarding analogous art had been provided at trial, and held that the jury's finding of non-analogous art was supported by substantial evidence. *Id.* 1773. Specifically, the court cited the criteria set forth in *In re Clay*, and noted that "[t]he Allen-Bradley art is not in the same field of endeavor as the claimed subject matter merely because it relates to memories ... [Allen-Bradley] involves memory circuits in which modules of varying sizes may be added or replaced; in contrast, the subject patents teach compact modular memories". *Id.* 1773.

In finding substantial evidence to support the jury's finding, the court noted that the Wang SIMMs were pertinent to the field of personal computers, and were designed to provide compact computer memory with minimum size, low cost, easy repairability, and easy expandability. *Id.* 1773. Contrastingly, the Allen-Bradley SIMMs were developed for use in a controller of much larger industrial machinery and could not be used in a personal

computer. *Id.* 1773. Thus, while the Wang SIMMs were purposefully designed to be small, size was not a consideration for the Allen-Bradley SIMMs. *Id.* 1773. For these reasons, the court held, the Allen-Bradley prior art was non-analogous and not reasonably pertinent to the '605 and '513 patents. *Id.* 1773.

The test set forth in *In re Clay* was also tellingly applied, for example, in *In re Oetiker*, which is cited by and discussed in MPEP §2141.01(a) in the context of determining analogously in the mechanical arts. *In re Oetiker*, 24 USPQ2d 1443 (Fed. Cir. 1992). In *In re Oetiker*, an improvement was claimed to a stepless, earless metal clamp, with the improvement being a preassembly hook which serves to both maintain a preassembly condition of the clamp and to disengage automatically when the clamp is tightened. *Id.* 1445. All claims were rejected over the combination of U.S. Patent No. 4,492,004 to Oetiker, which disclosed the unimproved clamp, and U.S. Patent No. 3,426,400 to Lauro, which disclosed a plastic hook and eye fastener for use in garments. *Id.* 1445.

Oetiker argued during prosecution that Lauro's garment hook was non-analogous art in that a person of ordinary skill seeking to solve the problem facing Oetiker would not look to the garment art for the solution. *Id.* 1445. The Examiner argued that because garments commonly use hooks for securement, a person faced with the problem of unreliable maintenance of the pre-assembly configuration of an assembly line metal hose clamp would look to the garment industry art. *Id.* 1445. On Appeal, the Board held that Lauro was analogous art because both Lauro's and the Oetiker's inventions relate to "a hooking problem". *Id.* 1445.

The court, however, disagreed, stating that it had not been shown that a person of ordinary skill seeking to solve the problem facing Oetiker would reasonably be expected or motivated to look to fasteners for garments. Furthermore:

The combination of elements from non-analogous sources, in a manner that reconstructs the applicant's invention only with the benefit of hindsight, is insufficient to present a *prima facie* case of obviousness. There must be some reason, suggestion, or motivation found in the prior art whereby a person of ordinary skill in the field of the invention would make the combination. That knowledge cannot come from the applicant's invention itself. *Id.* 1446.

Applying the criteria of *In re Clay* as interpreted in *Wang Laboratories, Inc.* and in *In re Oetiker*, the Russell patent is not in the same field of endeavor as the present

invention merely because both make use of directories. As mentioned, the Russell patent and the present invention are concerned with entirely different problems, such that one with ordinary skill in the art seeking to solve the problems addressed by the present invention would not have looked to the disclosure of the Russell patent for inspiration.

More specifically, in its discussion of the prior art, Russell identifies a number of problems. One such problem is that of client and server platforms being incompatible by virtue of having differing operating systems. As a result, the connection and communication between the client and server platforms must be of a type that is compatible with both operating systems and associated application and services programs.

Another problem arises from the inherent limitations of the connection and communication facilities associated with the client applications and with the inherent limitations of the server programs. These problems severely limit the capabilities of the client platforms and server platforms to communicate and to execute data storage and retrieval operations. The client platforms, for example, are frequently limited in the number of network connections that they can support. Traditionally, one network connection is provided for each client application, even if the connections are to the same server task. This in turn rapidly uses up the available client connections that can be supported by the client platform and results in a significantly slower startup time for each application when it attempts to connect to a server and has to wait until a connection is established.

Additionally, certain applications, such as those using Microsoft Windows, are pseudo-multitasking rather than true multitasking, so that only the application currently having the operating system context can send and receive messages, and are non-preemptive, so that the current application will complete all message operations before passing the context to another application, so that only one application may make use of the connections at a time. Still further, such applications may be synchronous in that they will send a message or a request for an operation and then will wait until a response is received before executing a next operation. Therefore, not only are the available connections rapidly used up, but a given application may significantly delay other applications access to the available connections by forcing the other applications to wait until the application having a connection completes all of its operations.

Additionally, the server platforms usually provide a server task which operates alone to service requests one at a time. This in turn requires that the server task queue or otherwise hold pending requests until the server task has completely finished with each prior request.

In contrast to the Russell patent, the present inventors were not focused on these problems when developing the present invention.

Russell also identifies other problems arising from providing system security. Such security usually involves checking the access authorizations of a user to various system resources, such as databases and electronic mail services. For example, one well known and often used authorization mechanism of the prior art involves an authentication server and a directory server wherein the directory server stores the authorization rights of the clients to various system resources and a set of individual passwords for the clients and for the system resources. The client makes a request to the authentication server for an identification packet which identifies the client and the authentication server provides a corresponding identification packet containing an identification of the client and this identification packet is encrypted using the password of the server as the encryption key. The client then sends the identification packet to the server, which decodes the identification packet with its password to obtain the identification of the client and uses this client identification to access the directory server to obtain the authorization rights of the client. This approach, however, places substantial burdens on both the directory server and the server which has been accessed, due to the number of directory access operations. In addition, this approach presents serious potential security problems in that all servers must have access to the directory server and must therefore be trusted, so that a false server could penetrate system security.

It will be appreciated that this last set of problems identified by Russell, though they relate to the broad problem of security, are also not relevant to the present invention or to the particular problems it addresses and attempts to solve.

- b. The disclosures of the Russell and Hartman patents do not teach or suggest every element and feature of the claims and therefore cannot support a proper obviousness rejection under 35 U.S.C. §103(a).

The Examiner must satisfy three criteria in order to establish the requisite *prima facie* case of obviousness: (1) there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or combine their teachings; (2) there must be a reasonable expectation of success; and (3) the prior art reference (or combination of references) must teach or suggest all the claim limitations. MPEP §706.02(j), citing *In re Vaeck*, 20 USPQ2d 1438 (Fed. Cir. 1991). Furthermore, "[t]he mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification." *In re Fritch*, 23 USPQ2d 1780, 1783-84 (Fed. Cir. 1992); see also *In re Gordon*, 221 USPQ2d 1125, 1127 (Fed. Cir.

1984). Additionally, "if the proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification." MPEP §2143.01.

In meeting this initial burden, the Examiner "cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention" *In re Fine*, 5 USPQ 2d 1596,1600 (Fed. Cir. 1988). The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on the applicant's disclosure. *In re Vaeck*, 20 USPQ 2d 1438, 1442 (Fed. Cir. 1991). Thus, "[m]easuring a claimed invention against the standard established by section 103 requires the oft-difficult but critical step of casting the mind back to the time of invention, to consider the thinking of one of ordinary skill in the art, guided only by the prior art references and the then-accepted wisdom in the field. See

As discussed above, the Applicant asserts that the Russell patent does not teach or suggest the features of the present invention, and this deficiency is not rectified by the disclosure of the Hartman patent.

With regard to the Examiner's specific assertions, the Applicant responds as follows:

"However, Hartman discloses a method to include a shopping cart (Fig. 1A) and storing the shopping cart along with the object in the directory (col. 3, lines 37-40)."

Response: The indicated text does not disclose how or where these objects are stored.

"As per Claims 6 and 12, Hartman discloses a method to include the steps of allowing the user to select items (Fig. 1A#102) and storing information relating to the selected items in the shopping cart (col. 3, lines 59-64 and col. 4, lines 19-24)."

Response: In contrast to the present invention, the Hartman patent does not disclose any method used to track this information, or where it is stored.

3. Conclusion

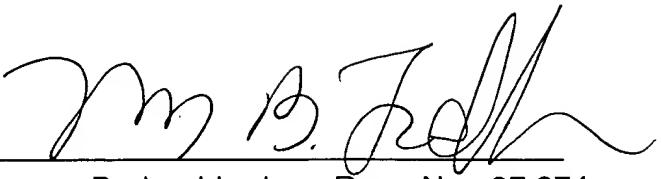
In light of the foregoing, the Applicant respectfully asserts that the claims of the present application are patentable over the cited prior art, and therefore respectfully requests a corresponding Notice of Allowance.

In the event of any questions, the Examiner is urged to call the undersigned. Any additional fee which might be due in connection with this application should be applied against Deposit Account No. 19-0522.

Appl. No.: 09/664,893
Reply to O.A. dated: 01/14/2004

Page 15 of 15

Respectfully Submitted,
HOVEY WILLIAMS LLP

By 

Thomas B. Luebbering, Reg. No. 37,874
2405 Grand Boulevard - Suite 400
Kansas City, Missouri 64108
(816) 474-9050

(Docket No. 30604)